

REMARKS

The undersigned, on behalf of the Applicants, would like to thank the Examiner for withdrawing all previous rejections on record. Applicants respectfully request entry of the present amendment, the consideration of the following remarks and the withdrawal of the pending rejection. Claims 158-164, 166-202, 205-207, 215 and 216 are pending in the application. Claim 158, 187, 205, 215 and 216 have been amended to correct a typographical error and further to better define the present invention. Entry of this response after the final rejection is permitted under 37 C.F.R. § 1.116, because the scope of the claims are not altered and the Examiner is not required to conduct additional search.

I. CLAIM OBJECTIONS

Claims 158-164 and 168-172 were objected for minor informalities. The claim 158 has been amended to correct the informality. Withdrawal of the objection is respectfully requested.

II. STATUS OF CLAIMS AND THE PROSECUTION HISTORY

In the Office Action mailed October 17, 2007, the Examiner declared claims 158-164, 166-202 and 205-207 as being allowed. The Examiner also indicated claims 215-216 would be allowed if they were to be written in an independent form to include all limitations of their base claims. Therefore, Applicants in their response filed February 18, 2008, rewrote claims 215 and 216 in the independent form to include all the limitations of their base claims.

In the Office Action dated May 28, 2008, the Examiner rejected all the claims allegedly based on the newly cited reference to which the Applicants successfully replied.

In the February 6, 2009 Office Action, the Examiner withdrew all prior rejections imposed on May 28, 2008. The Examiner now presents a new prior art rejection under 35 U.S.C. § 103(a) over Leaderman US 6,458,380 in view of Gallopo et al US, 2001/0002252 and Segal US Patent 5,891,453.

In accordance with the principles of compact prosecution, piecemeal Examination of the claims should be avoided. *See* MPEP § 707.07(g). The first Office action on the merits of a patent application should present the best case with all the relevant reasons, issues, and evidence so that all such rejections can be withdrawn if applicant provides appropriate convincing arguments and/or evidence in rebuttal. *See Id.*

Applicants respectfully submit that the Examiner's approach to the present claims amount to piecemeal Examination which has unduly delayed Applicants' securing the Notice of Allowance. Accordingly, Applicants request in selecting the references, the Examiner avoid using any unnecessary number of references which do not offer any new scientific or legal rationale, and merely stall, delay and prolong the prosecution of this application.

Despite issuance of a favorable opinion in the October 17, 2007, in a number of occasions the Examiner has reused the same scientific reasoning by merely exchanging the cited references which have already had been rendered disqualified or the teachings, the combination of which have been rendered improper or moot, i.e. Gallopo, Jenkins, Sagel, and Chen. Yet, the Examiner persists on the same scientific and legal rationale to essentially maintain the same improper rejection. Nevertheless, in the interest of addressing all issues raised, Applicants have in good faith addressed all imposed rejections, even though they are duplicate and merely cumulative in nature. Applicants respectfully submit that maintaining the rejection based on same rationale previously withdrawn is improper and unduly delays the issuance of a timely Notice of Allowance.

III. SUMMARY OF THE ARGUMENTS

Applicants respectfully argue that (1) Leaderman is not a competent prior art and reliance on it to reject the instantly claimed invention is improper; (2) the combination of Gallopo and

Sagel fails to meet each and every limitation of the present claims, and (3) the Examiner has employed extensive improper hindsight by picking and choosing to impose the rejection.

REJECTIONS OF CLAIMS 158-164, 166-202, 205-207, AND 215-216 OVER LEADERMAN US PATENT 6,458,380 IN VIEW OF GALLOPO US 2001/0002252,(US PUB OF WO '973 PUBLICATION 95/17158 AND SAGEL US PATENT 5,891,453 SHOULD BE WITHDRAWN.

The only rejection, now at issue, as set forth in the Office Action employs the combination of the teachings of Leaderman, Gallopo and Sagel.

Without discussing the scientific rationale of this rejection, Applicants respectfully submit that Leaderman is not a competent prior art and at least for such reasons, the rejection should be withdrawn. Leaderman's publication date is October, 1, 2002 which is after the earliest priority date of the present application. Therefore, Leaderman could only be available as a prior art under 35 U.S.C. §102 (e). Applicants respectfully submit that Leaderman earliest priority date is November 9, 2000. However, the present invention enjoys the priority of, *inter alia*, Korean patent application 2000-13636 ("priority document '636") filed March 17, 2000. Thus, Leaderman is not a competent prior art and can not be used against the present invention.

Leaderman was used by the Examiner for its teachings of a composition that can comprise hydrogen peroxide, a polymer such as polyvinylpyrrolidone, and a thickener such as hydroxypropyl methyl cellulose. *See* Office Action at pgs 2-3. Without being bound to any theory as to the correctness of such allegation, Applicants respectfully requests withdrawal of the rejection because Leaderman earliest priority date is after the earliest priority date of the present invention.

The Certified copies of the priority document '636 were not only submitted in the parent 10/049,817 application, but also in the reply filed on November 6, 2006 in the present application. As it has been argued throughout the prosecution of this application, the present Inventors are the first to teach the concept of using polyvinyl pyrrolidone ("PVP") with hydrogen

peroxide in a tooth whitening patch being in a dry state. Applicants disclosed the novel concept on pages 4 and 14 of the priority document '636 and the examples of pages 7-12. For such reasons, Leaderman is not a competent prior art, and for such reasons alone Applicants request withdrawal of the present rejection.

Furthermore, it is respectfully submitted that a proper 35 U.S.C. § 103(a) rejection requires that the prior art cited render all the limitations of the claims obvious to a person of ordinary skill in the art. Here, even if Leaderman was a competent prior art and the Examiner's practice of hindsight picking and choosing was proper, the combined teachings of all the references combined would still fail to meet every limitation of the present claims.

As it has previously been argued, independent claims 158 and 187 define the tooth whitening patch wherein it has a specific contact area width "in a dry state. . . wherein the patch has adhesive strength, and wherein the adhesive strength of the patch will increase upon becoming hydrated by applying the patch to a user's teeth." Likewise, claim 173 contains the limitation "wherein the patch is in a dry state such that about 10% or less of the materials will adhere to a dry surface upon contact with the surface, and is adapted to strongly adhere to a user's teeth upon becoming hydrated when applied to such a user's teeth."

Claims 215 and 216 define the tooth whitening patch comprising two layers, "wherein one of the layers is an active ingredient-containing adhesive layer for application to teeth . . . wherein the adhesive layer is in a dry state and has adhesive strength," and "wherein the adhesive strength of the adhesive layer will increase upon becoming hydrated by applying the adhesive layer to a user's teeth." None of the cited references disclosed the above limitations.

Contrary to the Examiner's position, Leaderman never discloses the combination of PVP, and hydrogen peroxide in any formulation. At most, Leaderman teaches the use of polycarbophil

with sodium hydroxide in its example 1. Leaderman makes a reference in passing to polyvinyl at col. 4, lines 4-5 of his Patent, but not in context for stabilizing hydrogen peroxide or use with hydroxypropyl methyl cellulose and tripolyphosphates. Accordingly, without employing improper hindsight, there would have been no motivation to make the modifications suggested by the Examiner. Nevertheless, since Leaderman is not a competent prior art and all independent claims were rejected relying on the teachings of Leaderman, then, the rejection of all dependent claims should also be withdrawn.

Galoppo and Sagel fail to teach multiple features of the present claims. In fact, Galoppo is not in the same field of endeavor as Leaderman or Sagel and thus not even combinable with their teachings. Galoppo is directed to tooth paste composition and far from any dry patch. Those of ordinary skill in the art would not have considered Galoppo's teachings for combination with either Leaderman or Sagel. In fact, not only Galoppo fails to make any reference to any patches, but it also fails to disclose or teach the use of PVP alone or in combination with other ingredients. It further fails to teach the combination of PVP with hydrogen peroxide, hydroxypropyl methylcellulose and sodium tripolyphosphate. For such reasons alone, the pending rejection should be withdrawn.

Sagel does neither remedy the shortcomings of Leaderman nor those it remedy the shortcomings Galoppo. Sagel specifically fails to mention the use of PVP and hydroxypropyl methylcellulose. Therefore, even if combined, the teachings of the cited references would have failed to meet all the limitations in the present claims.

Finally, since Leaderman is not a competent prior art and all of the independent claims were rejected relying on the teachings of Leaderman; then, the rejection of all independent and dependent claims should also be withdrawn.

For such reasons the rejection of claims 158, 173, 187, 215, 216, and all the other claims dependent thereon under 35 U.S.C. § 103(a) should be withdrawn.

CONCLUSION

Claims 158-164, 166-202, 205-207, and 215-216 are pending. Pursuant to the arguments presented above, Applicants respectfully request that the rejection in the Office Action dated February 6, 2009 be withdrawn and all the pending claims be declared allowable.

Applicants request that any questions concerning this matter be directed to the undersigned at 609-844-3030. If a telephone conference would be of assistance in advancing the prosecution of the present application, Applicants' undersigned attorney invites the Examiner to telephone at the number provided.

Applicant also authorizes the charge of any deficiency and/or the credit of any overpayment to Deposit Account No. 50-1943.

Please date stamp and return the enclosed postcard evidencing receipt of this document.

Date: July 7, 2009

Respectfully submitted,

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